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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,434	03/12/2004	Isabelle Bara	5725.0362-01	5266

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
YU, GINA C	

ART UNIT	PAPER NUMBER
1617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/798,434	BARA ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-60,62,63 and 65-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-60,62,63 and 65-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/277226.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of amendment filed on November 13, 2007. Claims 1, 4-60, 62, 63, and 65-69 are pending. Claim rejection made under 35 U.S.C. § 112, second paragraph, as indicated on previous Office action dated July 12, 2007, is withdrawn in view of the claim amendment. Claim rejections made under 35 U.S.C. §§ 102 (b) and 103(a) are withdrawn in view of applicants' remarks. Obviousness double patenting rejection is withdrawn in view of the claim amendment. New rejections are made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Merat et al. (US 5126136).

Merat discloses a process making a water-proof lotion by incorporating 2.5 % of dimethiconol poly[oxy(dimethylsilylene)], α-hydro-ω-hydroxy as a film former and water

proofing compound in an water and oil emulsion. See Example 3. See also Examples 5 and 7.

Claims 1, 4-19, 23-45, 48-52, 55-60, 62, 63, 66-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Nanba et al. (US 6063391).

Nanba teaches a method of making transfer-free lipstick composition by adding perfluoroalkyl denatured silicone, alkyl cyclopentasiloxane, and polyether denatured silicone in the oil phase. See instant claims 1, 12, 59. Polyether denatured silicone is KF 6008 from Shin-Etsu Chemical, which meets the oxyalkylenated silicone of the instant invention. Applicants disclose that KF 6008 is a substituted oxyalkylenated silicone which is useful for the present invention. The reference also teaches that the lipstick composition can be in the form of an emulsion. See col. 6, lines 18 –24. The claimed process of reducing or eliminating the transfer or migration of the composition is practiced every time the prior art is used as directed by the reference.

Also used in the Nanba composition are dyestuffs (titanium dioxide and red pigments) and fillers and organic resins. See instant claims 15, 16, and 18. Pearl agent is taught in col. 6, lines 16, see instant claim 17. The reference teaches that lipstick compositions are also formulated in form of liquid or emulsions and illustrates in Example 17 a formulation comprising 5 % of water. See col. 9, lines 49 – 60; instant claims 42, 43, 48. The volatile silicone oils of instant claims 23-27 are taught in col. 6, line54 – col. 7, line 52. The non-silicone fatty substances of instant claims 39-40 are taught in col. 6, lines 8 – 13, and Example 16 uses solid paraffin. The reference further teaches adding organic/inorganic powders to the lipstick formulations, and illustrates in

Example 18 a formulation comprising 5 % by weight of spherical silicone rubber powder. See instant claims 49-52. Nanba also meets the claimed limitation of the average refractive index of the totality of the silicone oil, since the prior art uses the same types of oils and fillers in the weight amounts as claimed in the present application. See instant claims 55-57. The silicone resins of instant claim 38 is taught in col. 6, lines 25 – 37.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanba as applied to claims 1, 4-19, 23-45, 48-52, 55-60, 62, 63, 66-69 as above, and further in view of Cosmetics Additives (1991).

Nanba fails to teach the dyes of instant claim 20.

Cosmetics Additives teaches quinolin yellow and tartrazine are commercially available colorants. See p. 70.

It would have been obvious to one of ordinary skill in the art to use commercially available dyestuff to conveniently make lipstick compositions of the combined references. No surprising or nonobviousness in using conventional dyestuff is seen, unless proven otherwise.

Claims 46, 47, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanba as applied to claims 1, 4-19, 23-45, 48-52, 55-60, 62, 63, 66-69 as above, and further in view of Handjani nee Vila et al. (US 3846556).

Since Nanba teaches making liquid and W/O emulsion compositions, making a W/O fluid emulsion would have been obvious. See instant claim 65. The reference does not specifically teach the amount of aqueous phase as required in claims 46 and 47.

Handjani teaches hydrating rouge comprising up to 50 % of an aqueous phase in water-in-oil emulsion. See Example 23.

Since Nanba teaches to make emulsion or liquid lipstick with the substituted silicone polyether of the instant claims, a skilled artisan would have been obviously motivated to look for the prior art such as Handjani and find the teachings on the amount of the aqueous phase.

Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanba as applied to claims 1, 4-19, 23-45, 48-52, 55-60, 62, 63, 66-69 as above, and further in view of Arraudeau et al. (US 5223559).

Although Nanba generally teaches fillers, the reference does not indicate the specific properties of the cosmetic fillers.

Arraudeau teaches cosmetic compositions comprising spherical or spheroidal particles having dimensions from 1-15 microns. See col. 3, lines 37 – 53. Powders of synthetic spheronized polymers and microspheres are taught. See col. 3, lines45 – 65.

The reference teaches adding colloids or film-forming polymers to "to favor the stability of the system or produce an additional film-forming effect". See col. 5, lines 56 – 65.

It would have been obvious to a skilled artisan to modify the teachings of Nanba by using spherical or spheroidal particles having particle size of 1-15 microns, as motivated by Arraudeau, because the latter teaches of specific types and properties of conventional cosmetic fillers. The skilled artisan would have had a reasonable expectation of successfully producing a lipstick emulsion comprising cosmetically sutiable fillers.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-45, 48-60, 62, 63, 65-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-67 of US Pat. No. 7264821 B2 in view of Nanba.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to the use of cosmetic compositions comprising same oxyalkylenated silicone substituted at the alpha- and omega positions and additives which overlap. While the '821 invention is an anhydrous composition, Nanba teaches that variation of emulsion, liquid, semi-solid, and solid composition is well within the skill of the art.

Claims 46, 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-67 of US Pat. No. 7264821 B2 and Nanba as applied to claims 1, 4-45, 48-60, 62, 63, 65-69 as above, and further in view of Handjani nee Vila et al. (US 3846556).

The '821 patent is relied upon as discussed above.

Nanba does not specifically teach the amount of aqueous phase as required in claims 46 and 47.

Handjani teaches hydrating rouge comprising up to 50 % of an aqueous phase in water-in-oil emulsion. See Example 23.

Since Nanba teaches to make emulsion or liquid lipstick with the substituted silicone polyether of the instant claims, a skilled artisan would have been obviously

motivated to look for the prior art such as Handjani and find the teachings on the amount of the aqueous phase.

Response to Arguments

Applicant's arguments filed November 13, 2007 have been fully considered but they are not persuasive in part and moot in view of new grounds of rejection in part.

Rejection under 35 U.S.C. § 112, second paragraph

Applicants' remarks concerning the previous rejection are moot in view of the claim amendment made by applicants.

Rejection under 35 U.S.C. § 102

Applicants assert that the silicone resin of the present claims differs from the silicone of Merat because the R1 group in applicants' formula (I) is limited to H, CH3 or CH2CH3 but the corresponding group of the prior art silicone is an OH group. Rejection on claim 3 is withdrawn in view of the claim amendment and rejection 8 is withdrawn in view of applicants' remarks. However, claims 1, 10, and 11 remain rejected because when R1 is hydrogen, R contains a hydroxyl group and reads on the prior art.

Rejection under 35 U.S.C. § 103

Applicants' arguments are moot in view of new grounds of rejection.

Obviousness double patenting rejection

A new rejection is made in view of claim amendment and applicants' remarks. Applicants' request to hold the rejection in abeyance until allowable claims are identified in the present application is acknowledged.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gina C. Yu
Patent Examiner